

Application Serial No. 10/695,886
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REMARKS

This is a full and timely response to the outstanding nonfinal Office Action mailed September 11, 2006. The Examiner is thanked for the thorough examination of the present application. Upon entry of the amendments in this response, claims 1-14, 20 and 21 are pending in the present application.

Applicant has amended the specification and claims 1, 11, and 20 to more clearly identify a novel and non-obvious aspects of embodiments. Applicant submits that no new matter is added to the application by this submission. Furthermore, it should not be presumed that Applicant agrees with any statements made by the Examiner in the Office Action unless otherwise indicated by the Applicant.

Applicant respectfully requests consideration of the following amendments and remarks contained herein. Reconsideration and allowance of the application and presently pending claims are respectfully requested.

I. Election/Restriction

A telephone interview was conducted with Applicant's attorney, Cynthia Lee, on August 7, 2006. Applicant appreciates the courtesy the Examiner extended to his representative in discussing this case. The discussion was directed to the Office Action's restriction requirement regarding the following inventions:

Group I: Claims 1-14 and 20-21

Group II: Claims 15-19

The Examiner has required the Applicant to elect to prosecute one of two groups of claims identified above in the Office Action. As discussed in a telephone conversation

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of August 7, 2006, and in response to the restriction requirement, Applicant respectfully elects to prosecute the claims of Group 1, corresponding to claims 1-14, 20 and 21.

II. Claim Objections

Claims 11 and 12 have been rejected under 35 U.S.C. §112, 6th Paragraph. Specifically, the Office Action states that the Applicant has invoked 35 U.S.C. §112, sixth paragraph in claim 11 and 12 by reciting "means for distinguishing." Office Action, pg. 3. Applicant has amended the specification as indicated above and respectfully submits that the objection should be withdrawn. Furthermore, Applicant submits that no new matter is added to the application by this submission.

III. Claim Rejections – 35 U.S.C. § 112

Claim 1 has been rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. More specifically, the Office Action states that claim 1 recites the limitation "the curve" and that there is insufficient antecedent basis for this limitation. Office Action, pg. 3. Without acquiescing to the rejection, Applicant has amended claim 1 to overcome this rejection.

III. Claim Rejections – 35 U.S.C. § 102

Claims 1-8, 11-14, and 20-21 have been rejected under 35 U.S.C. §102(b) as allegedly being anticipated by *Brunken* (European Patent No. 0 615 726 A1). For at least the reasons set forth below, Applicant traverses these rejections.

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Independent Claim 1

Claim 1 has been rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by *Brunken*. Applicant respectfully submits that independent claim 1 patently defines over *Brunken* for at least the reason that *Brunken* fails to disclose, teach or suggest certain features in claim 1.

Claim 1, as amended, recites:

1. A suture needle comprising:
a shaft, wherein the shaft is comprised of a front surface and a rear surface that extend side-by-side along at least a portion of a length of the shaft and wherein the shaft is marked at least partially with a visual indicator; and
a puncture tip at one end of a curve of the shaft.

(Emphasis added.) The Office Action alleges that "Brunken '726 discloses a needle with a curved cylindrical shaft (2, Figure 1) being marked at least partially with a visual indicator (page 2, lines 29-34) and a puncture tip (6) at one end of the curve (see Figure 1) of the shaft (2)." (Office Action, pg. 4) However, the Brunken reference does not teach at least the feature of "a shaft, wherein the shaft is comprised of a front surface and a rear surface that extend side-by-side along at least a portion of the length of the shaft and wherein the shaft is marked at least partially with a visual indicator" as recited in claim 1, as amended. (Emphasis added). The text cited by the Office Action states the following:

With the inventive surgical needle according to claim 2, the surface of the puncture tip and of the zone of the needle adjoining same consists of bare or untreated metal, while the surface of the remaining section of the needle, which can account for up to ca. 50% of the needle length, is matt-finished or coloured, continuously or with small breaks, by chemical or electrolytic means or by a covering, up to the thread attachment. With this version, the special advantages which were explained above in

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connection with the zone of the puncture tip apply to the rear section of the needle. Because of the surface treatment of the rear section, this stands in clear contrast to the remainder of the suture during operation.

(Emphasis added; page 3, lines 29-34). Furthermore, FIG. 1 of the *Brunken* reference is shown below:

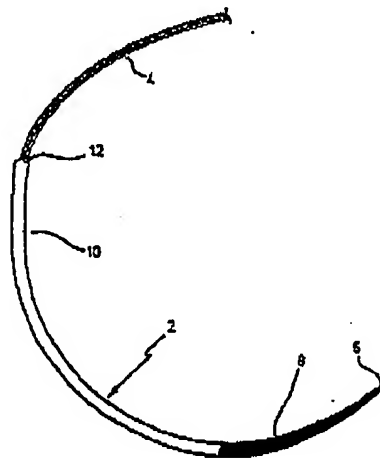


FIG. 1

As seen in the cited text and in the figure above, the *Brunken* reference does not teach at least the feature of "a front surface and a rear surface that extend side-by-side along at least a portion of the length of the shaft" and wherein the shaft is marked at least partially with a visual indicator" as recited in claim 1. The *Brunken* reference, instead, teaches that "the surface of the puncture tip and of the zone of the needle adjoining same consists of bare or untreated metal, while the surface of the remaining section of the needle, which can account for up to ca. 50% of the needle length, is matt-finished or coloured." (Emphasis added; page 3, lines 29-31). Unlike the *Brunken* reference, the present invention is comprised of a distinct front and rear surface that

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extends side-by-side along at least a portion of the length of the shaft. *Brunken* instead teaches different zones or sections and does not teach a suture needle comprised of two surfaces that extend side-by-side along at least a portion of the length of the shaft.

The first zone/section consists of bare or untreated metal, while the surface of the remaining section of the needle is matt-finished or coloured. This is clearly seen in FIG.1 of the *Brunken* reference above. (See zone (8) and section (10) in FIG. 1.)

Accordingly, for at least this reason, *Brunken* fails to disclose, teach or suggest the above-described features highlighted in claim 1. Therefore, Applicant requests that claim 1 be allowed and the rejection of claim 1 be withdrawn.

Dependent Claims 2-10

Because independent claim 1 patently defines over *Brunken*, dependent claims 2-10 are allowable over *Brunken* as a matter of law for at least the reason that claims 2-10 contain all the features and elements of their corresponding independent claim. See, e.g., *In re Fine*, 837 F. 2d 1071 (Fed. Cir. 1988).

Independent Claim 11

Claim 11 stands rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by *Brunken*. Applicant respectfully submits that independent claim 11 patently defines over *Brunken* for at least the reason that *Brunken* fails to disclose, teach, or suggest certain features in claim 11.

Claim 11, as amended, recites:

11. A suture needle comprising:
a puncture tip; and

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a shaft extending from the puncture tip, the shaft including means for distinguishing between a front surface of the shaft and a rear surface of the shaft, wherein the front surface and the rear surface extend side-by-side along at least a portion of the length of the shaft.

(Emphasis added.) The Office Action alleges that "Brunken '726 discloses a surgical needle with a curved cylindrical shaft (Figure 1) containing a puncture tip (6) and a shaft (2) extending from the tip (6) including a means for distinguishing between the front surface of the shaft (2) that is proximal to tip (6) and the rear surface of the shaft (2) that is distal to tip (6) (see Figure 1)." Office Action, pg. 5. However, Applicant respectfully submits that *Brunken* does not teach "wherein the front surface and the rear surface extend side-by-side along at least a portion of the length of the shaft" as recited in claim 11, as amended. As discussed above, *Brunken* instead teaches of different zones or sections and does not teach a suture needle comprised of two surfaces that extend the length of the shaft. The first zone/section consists of bare or untreated metal, while the surface of the remaining section of the needle is matt-finished or coloured. This is clearly illustrated in FIG.1 of the *Brunken* reference above. See zone (8) and section (10) in FIG. 1. Accordingly, for at least this reason, *Brunken* fails to disclose, teach, or suggest the above-described features highlighted in claim 11. Therefore, Applicant requests that claim 11 be placed in condition for allowance and the rejection of claim 11 be withdrawn.

Dependent Claims 12-14

Because independent claim 11 patently defines over *Brunken*, dependent claims 12-14 are allowable over *Brunken* as a matter of law for at least the reason that claims

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12-14 contain all the features and elements of their corresponding independent claim.

See, e.g., *In re Fine*, 837 F. 2d 1071 (Fed. Cir. 1988).

Independent Claim 20

Claim 20 stands rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by *Brunken*. Applicant respectfully submits that independent claim 20 patently defines over *Brunken* for at least the reason that *Brunken* fails to disclose, teach or suggest certain features in claim 20.

Claim 20, as amended, recites:

20. A method of making a suture needle, comprising the steps of:
providing a suture needle; and
marking at least a portion of the suture needle with a visual indicator, wherein the portion extends at least partially the length of the suture needle.

(Emphasis added.) The Office Action alleges that “*Brunken* ‘726 discloses a method of making a suture needle that includes providing a suture needle (page 3, lines 5-9) and marking at least a portion of the needle with a visual indicator (page 3, lines 14-17).”

Office Action, pg. 5. Applicant respectfully submit that *Brunken* does not teach of “marking at least a portion of the suture needle with a visual indicator, wherein the portion extends at least partially the length of the suture needle” as recited in claim 20,

as amended. The cited text in the *Brunken* reference states the following:

The needle 2 shown in Figures 1 to 3 is a normal semi-circular round-bodied needle; the needle can, however, have any desired form and be, for example, a blunt round-bodied needle, a cutting needle or a spatula needle. Located at one end of the needle 2 is the puncture tip 6, which can also be designed as a microtip, while a thread attachment 12, where a thread 4 made from surgical suture material is secured, is formed at the opposite end of the needle 2.

Emphasis added; page 3, lines 5-9.

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A suitable colouring or matt-finishing can be achieved either by chemical means through pickling or etching, or electrolytically through appropriate anodic or cathodic treatment, where appropriate with polarity inversion or through alternating current.

Emphasis added; page 3, lines 14-17. Applicant submit that there is no mention in the cited text above of "marking at least a portion of the suture needle with a visual indicator, wherein the portion extends at least partially the length of the suture needle."

Furthermore, as seen in FIGS. 1 and 3 of the *Brunken* reference, there is no indication of the section or zone extending the length of the suture needle. Accordingly, for at least this reason, *Brunken* fails to disclose, teach, or suggest the above-described features highlighted in claim 20. Therefore, Applicant requests that claim 20 be placed in condition for allowance and the rejection of claim 20 be withdrawn.

Dependent Claim 21

Because independent claim 20 patently defines over *Brunken*, dependent claim 21 is allowable over *Brunken* as a matter of law for at least the reason that claim 21 contains all the features and elements of the corresponding independent claim.

IV. Claim Rejections – 35 U.S.C. § 103

Claim 9 stands rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over *Brunken*, as applied to Claim 1, in view of *Anis* (U.S. Patent No. 5,352,233). Applicant respectfully submits that because independent claim 1 is allowable, as argued above, dependent claim 9 is allowable as a matter of law for at least the reason that the claim contains all elements, features and limitations of

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independent claim 1, from which claim 9 depends. Therefore, Applicant respectfully submit that the Examiner's rejection of claim 9 has been rendered moot, and claim 9 should be placed in condition for allowance.

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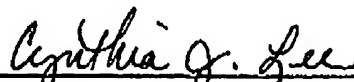
CONCLUSION

In light of the foregoing amendments and for at least the reasons set forth above, Applicant respectfully submits that all objections and/or rejections have been traversed, rendered moot, and/or accommodated, and that the now pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested.

Any other statements in the Office Action that are not explicitly addressed herein are not intended to be admitted. In addition, any and all findings of inherency are traversed as not having been shown to be necessarily present. Further, any and all findings of well-known art and official notice, or statements interpreted similarly, should not be considered well known for at least the specific and particular reason that the Office Action does not include specific factual findings predicated on sound technical and scientific reasoning to support such conclusions.

If, in the opinion of the Examiner, a telephone conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,


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